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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/682,421

10/09/2003

Janice Marie Girouard

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EXAMINER

DAILEY, THOMAS J

ART UNIT

PAPER NUMBER

2152

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/682,421	Applicant(s) GIROUARD ET AL.	
	Examiner THOMAS J. DAILEY	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,6-9,11,14-17,19 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 6-9, 11, 14-17, 19, and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 2, 4-5, 10, 12-13, 18, and 20-21 were cancelled.
2. Claims 1, 3, 6-9, 11, 14-17, 19, and 22-24 are pending.
3. In view of the appeal brief filed on November 11, 2007, PROSECUTION IS
HEREBY REOPENED. New grounds of rejection are set forth below.
4. To avoid abandonment of the application, appellant must exercise one of the
following two options:
 - (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a
reply under 37 CFR 1.113 (if this Office action is final); or,
 - (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31
followed by an appeal brief under 37 CFR 41.37. The previously paid notice of
appeal fee and appeal brief fee can be applied to the new appeal. If, however,
the appeal fees set forth in 37 CFR 41.20 have been increased since they were
previously paid, then appellant must pay the difference between the increased
fees and the amount previously paid.
5. A Supervisory Patent Examiner (SPE) has approved of reopening prosecution
by signing below:

/Bunjod Jaroenchonwanit/
Supervisory Patent Examiner, Art Unit 2152

Response to Arguments

6. Applicant's arguments with respect to claims 1, 3, 6-9, 11, 14-17, 19, and 22-24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 7-9, 11, 15-17, 19, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hursey et al. (US Pub. No. 2003/0023875 A1), hereafter "Hursey", in view of Winarski (US Pub. No. 2002/0133557) in further view of Smithson et al. (US Pat. No. 6,898,715 B1), hereafter "Smithson".
9. As to claims 1, 9, and 17, Hursey discloses a system and computer program product for accomplishing a method for mitigating self-propagating electronic mail viruses (Abstract), comprising:
- receiving a request to send electronic mail message with a file attachment to a plurality of intended recipient ([0033], lines 3-11 and [0035], lines 3-5);

calculating at least one number of said plurality of intended recipients in an address book storing each of said plurality of intended recipients ([0033], lines 3-11, see the response to arguments section for further elaboration on the interpretation of this claim);

retrieving a maximum recipient limit specified for at least one group identifier among said plurality of separate group identifiers ([0033], lines 11-13, threshold level reads on maximum recipient limit);

comparing a characteristic of said at least one intended recipient with said maximum recipient limit ([0033], lines 11-13); and

responsive to said at least one number of said plurality of recipients assigned to at least one group identifier in said address book exceeding said maximum recipient limit, exceeding said maximum recipient limit for said at least one group identifier ([0033], lines 11-16), requesting a sender authorization prior to sending said electronic mail message ([0033], lines 16-20), such that if a virus is attempting to self-propagate by sending said electronic mail message said attempt is mitigated ([0033], lines 20-25).

But, Hursey may not explicitly disclose the intended recipients are assigned to at least one group identifier in an address book and thus Hursey does not disclose in its entirety the calculating of at least one number of said plurality of intended recipients assigned to at least one group identifier in an address book storing each of said plurality of intended recipients in association with at least

Art Unit: 2152

one of a plurality of separate group identifiers as recited by the claim. Rather, Hursey discloses calculating the percentage of a client's total address book that are being addressed by an email and comparing that to a threshold ([0033]), not explicitly disclosing a client's address book may be subdivided into groups.

However, Winarski discloses email address books with group identifiers and manipulating emails based upon those group identifiers ([0055], lines 6-10; [0056], lines 1-4; [0057], lines 1-4, Winarski discloses an address book and addresses in that address book can be among priority, business, and personal address (i.e. group identifiers)).

To one of ordinary skill in the art the combination of Winarski and Hursey would yield the calculating of at least one number of said plurality of intended recipients assigned to at least one group identifier in an address book storing each of said plurality of intended recipients in association with at least one of a plurality of separate group identifiers, as a person of ordinary skill in the art at the time of the invention has good reason to pursue the known options (i.e. the teachings of Hursey and Winarski) within his or her technical grasp and, if this leads to anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In regards to the combination of Hursey and Winarski, it would have been obvious to one of ordinary skill in the art because such a combination would allow Hursey's detection and prevention of malware propagation to be extended to address books with subdivisions and such a

combination would have led to anticipated success as the predictable result of preventing the propagation of malware would be achieved as it is already disclosed in Hursey.

Further, Hursey and Winarski do not additionally disclose said maximum recipient limit also specifies for a particular extension type of file attachment from among a plurality of extension types of file attachments, wherein an extension type of said file attachment matches said particular extension type of said file attachment. Rather, Hursey and Winarski only disclose a maximum recipient limit for group identifiers not a recipient limit for group identifiers with specific file types.

However, Smithson discloses retrieving a maximum recipient limit (column 4, lines 24-44) specified for a particular extension type of file attachment from among a plurality of extension types of file attachments, wherein an extension type of said file attachment matches said particular extension type of said file attachment (column 4, lines 50-53).

Therefore, it would have been obvious at the time of the invention to combine the teachings of Hursey, Winarski, and Smithson thereby combining two known algorithms for preventing the propagation of undesirable email and in doing so creating a more robust overall algorithm.

Art Unit: 2152

10. As to claims 3, 11, and 19, Hursey, Winarski, and Smithson disclose the invention substantially with regard to the parent claims 1, 9, and 17, and further disclose detecting a file embedded within said electronic mail message as a file attachment (Hursey, [0037], lines 9-12).

11. As to claims 4, 12, and 20, Hursey, Winarski, and Smithson disclose the invention substantially with regard to the parent claims 1, 9, and 17, and further disclose:

comparing at least one address for said at least one intended recipient with an address book of a plurality of recipients (Hursey, [0033], lines 3-14);

calculating a number of said at least one address of said at least one intended recipient matching addresses within said address book of said plurality of recipients (Hursey, [0033], lines 3-11); and

determining whether a number of said matching addresses exceeds a maximum limit of addresses within said address book of said plurality of recipients (Hursey, [0033], lines 11-16).

12. As to claims 7, 15, and 23, Hursey, Winarski, and Smithson disclose the invention substantially with regard to the parent claims 1, 9, and 17, and further disclose receiving said maximum recipient limit from at least one of a network administrator and a user (Hursey, [0033], lines 11-14).

Art Unit: 2152

13. As to claims 8, 16, and 24, Hursey, Winarski, and Smithson disclose the invention substantially with regard to the parent claims 1, 9, and 17, and further disclose responsive to receiving a denial of said sender authorization, alerting a network administrator that said electronic mail message was blocked (Hursey, [0033], lines 25-28).

14. Claims 6, 14, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hursey and Winarski in view of Smithson as applied to claims 1, 9, and 17, in further view of Henderson (US Pat. No. 6845448 B1).

15. As to claims 6, 14, and 22, Hursey, Winarski, and Smithson disclose the invention substantially with regard to the parent claims 1, 9, and 17, but do not explicitly disclose requesting at least one of an entry of a password as authorization and a manual sender input.

However, Henderson discloses requesting at least one of an entry of a password as authorization and a manual sender input (column 1, lines 65-67 and column 2, lines 1-2).

Therefore, it would have been obvious at the time of the invention to combine the teachings of Hursey, Winarski, and Smithson, with the teaching of Henderson in order to provide secure transmission of electronic mail messages (Henderson, column 1, lines 65-67).

Conclusion

16. Applicant's amendment filed March 3, 2007 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Dailey whose telephone number is 571-270-1246. The examiner can normally be reached on Monday thru Friday; 9:00am - 5:00pm.
19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax

Art Unit: 2152

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. J. D./
Examiner, Art Unit 2152

/Bunjob Jaroenchonwanit/
Supervisory Patent Examiner, Art Unit 2152